

REMARKSThe Claim Amendments

Applicants have amended claim 1, canceled claims 4-15 and 25-27 without prejudice,¹ and added claims 28-39. Thus, claims 1, 16-24 and 28-39 are pending.

Applicants have amended claim 1 to delete the recitation that Q₁ may be a 5-7 membered aromatic or non-aromatic carbocyclic ring and to delete the proviso. Support may be found throughout the specification. See, e.g., originally-filed claim 1 and Table 1 (pages 13-106) of the specification (e.g., compounds 64-65; 69-71, 75-77, 81, 85, 86, 90, 91, 95, 96, 103, 104, 108-113, 118, 122, 1214, 127, 129, 132, 135, 138, 141, 148, 149, 152-154, 156, 158-161, 163, 165, 167-170, 172-175, 177-179, 181-184, 186-188, 190-193, 195-197, 201-353 and 355-356), which provides numerous examples in which Q₁ is other than a 5-7 membered aromatic or non-aromatic carbocyclic ring.

Applicants have added claim 28 to recite specific compounds that fall within the scope of claim 1. Support for the specific compounds may be found in Table 1 of the specification.

Applicants have added claims 29 and 30 to recite a pharmaceutical composition comprising the compounds of claims 1 or 28 as well as a method for treating Parkinson's disease in a patient in need thereof. Support may be found in originally-filed claims 4 and 10 and on page 109, line 30 to page 110, line 10.

Applicants have added claims 31-36 to recite compounds of the invention. Support for claim 31 may be found in originally-filed claims 1 and 2; on page 11, line 26 to page 12, line 28 of the specification and in Table 1 (e.g.,

¹ In the December 22, 2003 response, there were two claims numbered 17. Thus, the second instance of claim 17 has been renumbered as claim 18, and former claims 18-26 have been renumbered as claims 19-27, respectively.

compounds 1-15, 17-22, 24-30, 32-36, 38-44, 46-52, 54-68, 72-74, 78-80, 82-84, 87-89, 92-94, 97-102, 105-107, 117, 131, 134, 137, 140, 141, 150-151, 155, 162, 164, 166, 171, 176, 180, 185, 189, 194, 198-200 and 354), which provides numerous examples in which Q₁ is a substituted phenyl group. Support for the recitation that R³ may be an aromatic heterocycle is found in originally-filed claim 1 and throughout the specification (see, e.g., page 12, lines 24-27 and compounds 182-186 of Table 1).

Support for added claim 32 may be found on page 12, lines 15-18. Support for added claim 33 may be found on page 12, lines 20-22. Support for added claim 34 may be found on page 12, lines 24-27 and in compounds 182-186 of Table 1 of the specification. Support for added claim 35 may be found on page 12, line 29. Support for added claim 36 may be found in originally-filed claim 2.

Applicants have added claim 37 to recite specific compounds that fall within the scope of claim 36. Support for the specific compounds may be found in Table 1 of the specification.

Applicants have added claims 38 and 39 to recite a pharmaceutical composition comprising the compounds of claims 31 or 37 as well as a method for treating Parkinson's disease in a patient in need thereof. Support may be found in originally-filed claims 2, 4 and 10 and on page 109, line 30 to page 110, line 10.

None of the amendments adds new matter. Their entry is requested.

Applicants reserve the right to pursue the canceled subject matter in future continuation or divisional applications.

The ResponseOath/Declaration

The Examiner states that the oath or declaration is defective because non-initialed and/or non-dated alterations have been made to inventor Susanne Wilke's address.

As noted previously, applicants have been unable to locate Ms. Wilke and are still in the process of trying to find her. If applicants are unable to do so, applicants will file a declaration and petition pursuant to 37 C.F.R. § 1.47(a) to comply with the requirements of 37 C.F.R. § 1.52(c).

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner has rejected claim 24 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants have canceled claim 25 (numbered as claim 24 in the December 22 response), thus obviating this rejection.

The Rejections Under 35 U.S.C. § 112, First Paragraph

The Examiner has rejected claims 5-13 and 24-25 under 35 U.S.C. § 112, first paragraph. The Examiner contends that the specification, while being enabling for treating Parkinson's disease, does not reasonably provide enablement for treating the multitude of diseases embraced by these claims.

To expedite prosecution, applicants have canceled claims 5-13 and claims 25-26 (numbered as claims 24-25 in the December 22 response), thus obviating this rejection.

Applicants note that added claims 30 and 39 recite a method for treating Parkinson's disease in a patient in need thereof,

which the Examiner has acknowledged is enabled by the specification.

The Examiner has rejected claims 1 and 4-26 under 35 U.S.C. § 112, first paragraph as allegedly containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the invention was made, had possession of the claimed invention. Specifically, the Examiner states that the proviso in claim 1 lacks description.

Applicants have deleted the proviso in claim 1, thus obviating the rejection.

The Priority Claim

The Examiner states that applicants' claim for priority under 35 U.S.C. § 119(e) is acknowledged, but states that the provisional application from which priority is claimed fails to provide adequate support under 35 U.S.C. § 112 for claims 1 and 4-26 of the instant application.

Without acquiescing to the Examiner's assertion regarding applicants' claim for priority, applicants have amended the instant claims to overcome Gaeta et al. (WO 99/65875 A1), hereafter "the '875 application," as discussed below.

The Rejections Under 35 U.S.C. §§ 102(a) and/or 103(a)

The Examiner has rejected claims 1, 4, 5, 13-15 and 17-23 under 35 U.S.C. § 102(a) as allegedly being anticipated by the '875 application. The Examiner states that Compound XI of the '875 application fits formula I when $R^1 = R^2 = R^3 = \text{hydrogen}$, $R^4 = R^5 = \text{the non-aromatic heterocyclic ring piperazine}$, $Y = \text{CH}_2-Q_1$, and Q_1 is the substituted phenyl group 2,6-dichlorophenyl. Applicants traverse in light of the amended claims.

Applicants have amended claim 1 to delete the recitation that radical Q₁ may be a 5-7 membered aromatic or non-aromatic carbocyclic ring. Further, radical R³ cannot be a non-aromatic heterocycle in added claim 31. Consequently, none of the instantly claimed compounds, compositions and methods of use are anticipated or rendered obvious by the '875 application.

The Examiner has rejected claim 24 under 35 U.S.C. §102(a) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over the '875 application.

Applicants have canceled claim 24 (renumbered as claim 25), thus obviating this rejection.

WO 96/16046 and EP 685 463 A1 Applications

The Examiner had previously rejected claim 1 under 35 U.S.C. §102(b) as being anticipated by WO 96/16046 ("the '046 application") and EP 685 463 A1 ("the '463 application"). Applicants traverse insofar these rejections may be applied to the pending claims.

Applicants have amended claim 1 to delete the recitation that radical Q₁ may be a 5-7 membered aromatic or non-aromatic carbocyclic ring. Thus, none of the instantly claimed compounds, compositions and methods of use are anticipated or rendered obvious by either the '046 application or the '463 application.

The Species Claims

The Examiner had previously objected to claim 3 under 37 C.F.R. §1.141(a) as containing an unreasonable number of species. Applicants traverse insofar as this objection may be applied to claims 28 and 37.

Claims 28 and 37 recite specific compounds that fall within the scope of claims 1 and 31, respectively. Applicants respectfully submit that claims 1 and 31 are allowable. Thus, the compounds recited in claims 28 and 37 should not require any additional search on the part of the Examiner and should be found allowable as well.

Conclusion

Applicants request that the Examiner enter the above amendments, consider the accompanying arguments, and allow the claims to pass to issue. Should the Examiner deem expedient a telephone discussion to further the prosecution of the above application, applicants request that the Examiner contact the undersigned at his convenience.

Respectfully submitted,

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